

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on December 1, 2004, the Examiner rejected claims 1-23.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-16 and 18-23 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,295,064 to Malec. Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). **Any such suggestion must be found in the prior art, and not based on applicants disclosure.** *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). A clear and particular showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicants claims are not obvious in view of the prior art references.

Claim 1 includes the following limitation, “one or more **transceiver** units for sending information **to the plurality of display units** and being **located proximate to promoted items** ...”. The Examiner appears to accept that this limitation is not clearly anticipated or taught in Malic. However, the Examiner states, “One issue with Malec’s invention is that it requires the on board display electronics to search for messages associated with a particular transmitter, thus requiring expensive on board memory for every cart ... Therefore it would have been obvious to one of ordinary skill in the art to replace the transmitters with transceivers to make the invention as claimed. ...”. Office Action pages 2-3.

The only items taught in Malec that are located “proximate to promoted items” are elements 512 referred to as Trigger Transmitters (TTs). The TTs do not transmit any promotional information, rather they simply transmit “a unique address” “at a very short ... duty cycle to conserve battery power”. Malec Column 8, Lines 41-51. The specific indication in Malec to utilize low power battery operated TTs clearly teaches away from replacing them with high powered transceivers that actually transmit information to the display units. As discussed above, the necessary suggestion or motivation for obviousness must be found within the cited reference and not based on impermissible hindsight. Therefore, Malec fails to teach the cited limitation in claim 1.

In addition, claim 1 includes the following limitation, “a computer for operating the **interaction between the plurality of display units, the plurality of transceiver units, and the transmitter**”. The Examiner cites element 502 which is the in-store computer (ISC). However, the ISC in Malec does not interface with the TTs in any way. Malec Column 7 , Lines 28-31. As discussed above, the TTs are merely triggering devices and do not communicate information. Therefore, the ISC does not communicate with the TTs and fails to teach the cited limitation in

claim 1. Likewise, Malec fails to teach the limitation “a transmitter for sending information to the plurality of transceiver units”. No information is transmitted to the TTs by the ISC and therefore Malec does not teach this limitation either.

Further, Claim 1 includes the limitation, “an audible alert component on the display unit for signaling receipt of information from the transceiver unit”. The Examiner cites elements 1308 and 1309 in Figure 10. These elements merely indicate that the device taught in Malec is capable of producing sound. Malec, Column 23, Lines 5-9. There is no teaching of an audio output in response to the SDC receiving information from the ISC. Therefore, Malec also fails to teach this limitation.

The proposed modification of “replac[ing] the transmitters with transceivers to make the invention as claimed”, suggested by the Examiner on page 3 of the Office Action, fails to produce a working system. The system taught in Malec is designed around direct communication between the ISC and the SDCs. As discussed above, obvious modifications or combinations must contain a reasonable expectation of success in order to be valid. Merely stating that one component can be swapped with another does not address the significant system restructuring required for the system in Malec to incorporate transceivers as suggested by the Examiner. Therefore, for at least the reasons stated above, Malec fails to teach the limitations in claim 1. Applicants respectfully request the withdrawal of this rejection.


Claims 2-23 are dependent from claim 1 and are therefore allowable for at least the same reasons stated above.

CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 23 day of February, 2005.

Respectfully submitted,



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